REMARKS

The Examiner is thanked for the indication of allowable subject matter in claims 6, 8, 22, and 24. Reconsideration of the application in view of the foregoing amendments and following remarks is respectfully requested. Claims 1, 4, 9, 17, 20, and 25 have been amended to claim the invention more distinctly. No claims have been added. Therefore, claims 1-6, 8-22, and 24-32 are currently pending in the application.

Specification

In the Office Action, the Examiner objected to the specification for containing an embedded hyperlink, and required that such hyperlink be removed. While Applicant would like to comply with this request, Applicant is in a quandary as to how to do this. The application was not filed in electronic form but rather in paper form. Thus, Applicant did nothing to embed a hyperlink or browser executable code into the application. Applicant merely included a web site address in the text of the application. It appears that it was software at the Patent Office that converted the web site address into a hyperlink. Since Applicant has no control over such software, it is respectfully submitted that Applicant does not have the ability to comply with the Examiner's requirement, and hence, request that this objection be withdrawn.

Claim Rejections – 35 U.S.C. § 112

In the Office Action, the Examiner rejected claims 1-6, 8-22 and 24-32 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The

Examiner stated that "the term 'approximation' in the claims is a relative term which renders the claim indefinite" and "it is not clear what the meets and bounds [are] of 'approximate' in the context of claims 1 and 17."

While Applicant disagrees with this contention, Applicant has nonetheless, in the interest of furthering prosecution, amended claims 1 and 17 to remove this term.

Claim 1, as amended, now recites:

> A computer-implemented method for generating a transformation document, comprising:
>
> analyzing a first document;
>
> analyzing a second document, wherein said second document comprises a plurality of data structure patterns; and
>
> automatically generating, based upon said first and second documents, a transformation document which, when processed in conjunction with said first document, gives rise to a result document that comprises a substantial portion of the plurality of data structure patterns in said second document. (emphasis added).

Note that the term "approximation" has been removed and the phrase "comprises a substantial portion of the plurality of data structure patterns" has been added in its place. Applicant respectfully submits that, as amended, claim 1 is definite and satisfies the requirements of 35 U.S.C. §112, second paragraph. Support for this amendment can be found in the Specification at least in the Summary of the Invention section. In light of the above amendment, Applicant requests that the rejection of claim 1 under 35 U.S.C. §112, second paragraph, be withdrawn.

A similar amendment has been made to independent claim 17. Thus, Applicant requests that the rejection of claim 17 under 35 U.S.C. §112, second paragraph, also be withdrawn.

Claims 2-5, 8-16, 18-22, and 24-32 depend from claims 1 and 17. By virtue of the amendments to claims 1 and 17, these claims have also been rendered definite.

Consequently, Applicant requests that the rejection of these claims under 35 U.S.C. §112, second paragraph, be withdrawn as well.

Claim Rejections – 35 U.S.C. § 102(e)

In the Office Action, the Examiner rejected claims 1-4, 14, 17-20 and 30 under 35 U.S.C. § 102(e) as being anticipated by Huang et al. (U.S. 2002/0147748 A1, filed 04/2001). This rejection is respectfully traversed.

In rejecting the above claims, the Examiner relied upon certain subject matter in Huang et al. This reliance is proper only if it can be shown that Huang et al. qualifies as a prior art reference. The Examiner has made no such showing.

First of all, it is noted that Huang et al. was filed (April 8, 2002) after the filing date of the present application (August 16, 2001). Thus, based upon its own filing date, Huang et al. does not qualify as prior art under 35 U.S.C. §102(e). Huang et al. does, however, claim priority to four previously filed applications. Thus, Huang et al. may still qualify as prior art under 35 U.S.C. §102(e) if it can be shown that: (1) at least one of the previously filed applications has a filing date that precedes the filing date of the present application; AND (2) that the subject matter relied upon in Huang et al. to reject the claims was disclosed in the previously filed application.

Huang et al. claims priority to the following four applications: (1) U.S. Provisional Application No. 60/282,609, filed Apr. 9, 2001 (hereinafter the "April filing"); (2) U.S. Provisional Application No. 60/306,095, filed Jul. 17, 2001 (hereinafter the "July filing"); (3) U.S. Provisional Application No. 60/314,592, filed Aug. 23, 2001 (hereinafter the "August filing"); and (4) U.S. Provisional Application No. 60/349,957,

filed Jan. 17 (hereinafter the "January filing"). Of these four applications, only the April filing and the July filing have filing dates that precede the filing date of the present application. Thus, in order for Huang et al. to qualify as prior art, it must be shown that the subject matter relied upon in Huang et al. to reject the claims was disclosed in one of these applications.

Applicant notes that both the April filing and the July filing were provisional applications. That being the case, there is no guarantee that they contain the same subject matter as Huang et al., a non-provisional application. It is notoriously well-known that a provisional application may contain very little of the subject matter disclosed in a non-provisional application. Put another way, it is well-known that a non-provisional application can claim the benefit of a provisional application even though that provisional application may contain very little of the subject matter disclosed in the non-provisional application. Thus, just because a non-provisional application claims the benefit of a provisional application does not mean that the provisional application discloses the subject matter disclosed in the non-provisional application. Absent a specific showing that the provisional application discloses the subject matter relied upon in the non-provisional application to reject one or more claims, it cannot be concluded that the non-provisional application qualifies as prior art to reject those claims.

In rejecting the above claims, the Examiner has made reference only to the subject matter disclosed in Huang et al., the non-provisional application. The Examiner has provided no showing that the subject matter relied upon in Huang et al. to reject the claims is disclosed in either the April filing or the July filing. Absent such a showing, the Examiner cannot establish a basis for using Huang et al. as a prior art reference. Absent

such a basis, the Examiner cannot establish a prima facie case of unpatentability. Because the Examiner has failed to establish a prima facie case of unpatentability, Applicant submits that the rejection of claims 1-4, 14, 17-20 and 30 under 35 U.S.C. § 102(e) is improper, and requests that this rejection be withdrawn.

Claim Rejections – 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected claims 5, 13, 21 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Huang et al. as applied to claims 1 and 4 above, and further in view of Menke (U.S. 2002/0123878 A1, filed 02/2001). The Examiner also rejected claims 9 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Huang et al. as applied to claim 1 above, and further in view of Wheeler et al., (U.S. 2002/0055932 A1, priority filed 08/06/2001). The Examiner also rejected claims 10-11 and 26-27 under 35 U.S.C. § 103(a) as being unpatentable over Huang et al. and Wheeler et al. as applied to claim 9 above, and further in view of Menke. The Examiner also rejected claims 12 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Worden et al. further in view of Wheeler et al. as applied to claim 11 above, and further in view of Weinberg et al. (U.S. 2002/0194196 A1, priority filed 10/2000). The Examiner also rejected claims 15-16 and 31-32 under 35 U.S.C. § 103(a) as being unpatentable over Huang et al. as applied to claim 1 above, and further in view of Worden, et al. (U.S. 2003/0149934 A1, priority filed 05/2001). All of these rejections are respectfully traversed.

As argued above in connection with the rejection under 35 U.S.C. § 102(e), the Examiner has failed to show that Huang et al. qualifies as a prior art reference. Since all

of these rejections rely at least in part on Huang et al., Applicant respectfully submits that these rejections are improper, and requests that the rejections be withdrawn.

At this point, it is noted that Applicant has chosen not to address the substantive arguments set forth by the Examiner. This choice should not be interpreted as an admission that the Examiner's arguments are correct or as an acquiescence to the Examiner's position. Rather, since the Examiner has failed to establish a prima facie case of unpatentabililty, Applicant does not see a need to address these arguments at this time. Applicant reserves the right to address these arguments at a later time, should the need arise.

CONCLUSION

For the reasons given above, Applicant submits that the pending claims are patentable over the art of record, including the art cited but not applied. Accordingly, allowance of all pending claims is respectfully solicited.

The Examiner is invited to telephone the undersigned to discuss any issue that may advance prosecution.

No fee is believed to be due specifically in connection with this Reply. The Commissioner is authorized to charge any fee that may be due in connection with this Reply to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Dated: December 6, 2005

Bobby K. Truong
Reg. No. 37,499

Hickman Palermo Truong & Becker LLP
2055 Gateway Place, Suite 550
San Jose, CA 94110
Telephone No.: (408) 414-1080
Facsimile No.: (408) 414-1076

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

on December 6, 2005 by